

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ASHOK KUPPUSAMY, JAMES N. HELFRICH,
JOHN DAVID GRIFFIN, and JOE K. YAP

Appeal No. 2003-0637
Application No. 09/103,414

Heard : November 6, 2003

Before KRASS, DIXON, and SAADAT, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-21, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a system and method for updating a table of contents in a frameset. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. In a computer system, a method of creating a frameset including a table-of-contents ("TOC") linked to a target document, the method comprising the steps of:

creating the frameset having a TOC document in a first frame and the target document in a second frame, the target document being directly editable, and wherein at least a portion of the TOC document and at least a portion of the target document are visible;

creating an entry in the TOC document, the entry comprising a link to a selected part of the target document, the target document, responsive to a triggering of the link, operative to present the selected part as the visible portion of the target document; and

updating without direct manual intervention the entry in the TOC document in response to an edit to the selected part of the target document.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

DeRose et al. (DeRose)	5,893,109	Apr. 6, 1999 (Filed mar. 15, 1996)
Sotomayor	5,963,205	Oct. 5, 1999 (Filed Jun. 14, 1995)
Lin	5,978,818	Nov. 2, 1999 (Filed Apr. 29, 1997)

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Brown, Mark R., "Using Netscape 3," pp 44, 99, 476-468, and 545-555, Copyright date 1996 Que Corporation. (Brown)

Windows 95 Explorer, 1995 Microsoft Corp., Screenshots pp 1-8. (Windows)

Claims 1, 4-5, 8-13, 15, and 17-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Lin and Windows. Claims 3, 20 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Lin and DeRose in view of Windows. Claims 2, 6-7, 14, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Lin and Sotomayor in view of Windows.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 25, mailed Oct. 23, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 24, filed Jul. 22, 2002) and reply brief (Paper No. 26, filed Dec. 23, 2002) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531,

1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or individual to combine the relevant teachings of the references." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1.

Appellants argue that Windows does not employ, nor suggest framesets as described in the present invention. (See brief at page 6 and reply at 2.) Appellants argue that Windows does not disclose display of documents, but merely displays information about files stored on a file system. (See brief at page 6 and reply at 2.) Appellants argue that the examiner's view that framesets and windows are synonymous

is incorrect. (See reply brief at page 2.) Appellants argue that framesets are defined in the specification and that as defined is completely different than frames. (See reply brief at page 2.) Appellants argue that Windows does not disclose or suggest the display of different documents in two or more independent windows. (See reply brief at page 3.) We agree with each of appellants' arguments.

Appellants argue that the examiner has not provided any insight as to how the Netscape can be modified by the file manager of Windows. (See brief at page 7.) We agree with appellants that the examiner has not provide any reasoned analysis of how and why it would have been obvious to one of ordinary skill in the art to modify the system of Netscape with the file manager of Windows. Appellants argue that the system of Windows which includes the ability to modify the certain properties of folders and documents does not describe or suggest a target document as being directly editable within a frameset. (See brief at pages 7 and 8.) Appellants distinguish the editing of the properties of a document from the actual document. (See brief at page 8.) We agree with appellants and do not find the editing of the properties of a document, such as, its name to be suggestive of the editing of the document itself. Appellants argue that Lin does not teach or suggest updating a TOC document in response to an edit of the target document. (See brief at pages 8-9.) Appellants argue that Lin requires substantial manual intervention and that the report outline can only be updated by providing a new report and outline criteria by the user and repeating the

entire generation process. From our review of the teachings of Lin, we agree that Lin does not teach or suggest “updating without direct manual intervention the entry in the TOC document in response to an edit to the selected part of the target document” as required by independent claim 1.

Throughout the reply brief appellants argue that all of the claim limitations are not met and that the examiner has not provided a convincing line of reasoning for combining the various teachings. (See reply brief at pages 2-5.) We agree with appellants that the examiner has found various terms and concepts in appellants’ claimed invention, but the examiner has not provided a convincing line of reasoning to modify the separate teachings and to combine those modified teachings to arrive at the invention recited in independent claim 1. Therefore, we will not sustain the rejection of independent claim 1 and its dependent claims. With respect to the examiner’s reliance upon the teachings of Sotomayor and DeRose for dependent claims, we do not find that the teachings of Sotomayor and DeRose remedy the above noted deficiencies. Similarly, we do not find that the examiner has established a ***prima facie*** case of obviousness of independent claim 13 and its dependent claims.

With respect to independent claim 20, we find similar deficiency in the examiner’s ***prima facie*** case of obviousness and do not find that the teachings of DeRose remedy the above deficiencies. Therefore, we will not sustain the rejection of independent claim 20 and its dependent claim.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-21 under
35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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CHRISTOPHER J. LEONARD
MERCHANT & GOULD
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903